

REMARKS/ARGUMENTS

Applicant has carefully considered the Office Action mailed November 15, 2006, and respectfully requests reconsideration in view of the following remarks.

Applicant hereby requests acknowledgement of the Information Disclosure Statement filed July 9, 2004.

Claim Rejections—35 U.S.C. § 102(e)

Claims 19-25 and 27-33 stand rejected under 35 U.S.C. § 102(e) as being allegedly unpatentable by McIntosh (US 5,103,404) in view of Applicant's alleged Admitted Prior Art (AAPA). This rejection is respectfully traversed.

A claim is anticipated under 35 U.S.C. § 102(e) if “the invention was described in . . . a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent.” Anticipation under 35 U.S.C. § 102 can only occur if “every element of the claimed invention [is] identically shown in a *single reference*,” *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1556, 1567 (Fed. Cir. 1990) (emphasis added); *see also* Manual of Patent Examining Procedure (MPEP) § 2131. Thus, a claim cannot be unpatentable under 35 U.S.C. § 102(e) “in view of” other prior art. Therefore, the Examiner's rejection based on McIntosh “in view of” the AAPA is improper and therefore the rejection should be withdrawn.

The Examiner admits that “McIntosh does not disclose wherein the haptic feedback including a modulating force simulating a plurality of electronically defined stop positions” (p. 3). This is an admission that all the elements of independent claims 19, 25, and 31 are not found in a single reference as required by *Bond*. Although the Examiner's review of the AAPA is not relevant to a § 102(e) rejection, it is nevertheless untrue that “in view of” the AAPA, claims 19,

25, and 31 are obvious. If the Examiner had rejected these claims based on § 103, the Examiner would bear the initial burden of factually supporting any *prima facie* conclusion of obviousness. *See, e.g., In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). It is not enough simply to point out another source of prior art with which a reference can be combined, the Examiner must also show that the prior art teaches or suggests the desirability of the combination. *See In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). Moreover, the two references to be combined must be in the same or an analogous field. *See In re Oetiker*, 977 F.2d 1443, 1446, 24 U.S.P.Q.2d 1443, 1445 (Fed. Cir. 1992).

The section of Applicant's specification which the Examiner refers to as the "AAPA" discusses an old film editing system with a control wheel producing "clicks" as the wheel is rotated, caused by the geometry of the wheel as it is rotated. This video editing system was not a haptic device, and there was no motivation to use a haptic device in such a system. The field of haptics is not analogous with the field of passive mechanical knobs, and therefore it is improper to combine the AAPA with McIntosh.

Indeed, the nature of the video control system teaches away from using haptic devices, as video control systems of the past would only need exactly 24 or 30 clicks per rotation, which could effectively be accomplished by a passive mechanical knob. (*See Spec. p. 3.*) Thus, the Examiner's rejection of independent claims 19, 25, and 31 should be withdrawn.

As to dependent claims 20–24, 27–30, and 32–33, the argument set forth above is equally applicable here. The base claims being allowable, the dependent claims must also be allowable. *See In re Fine*, 837 F.2d 1071, 1076, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988). Moreover, the Examiner's rejection of claims 24 and 29 under § 102(e) as anticipated by McIntosh in further view of Sanderson (US 4,768,412) is doubly inappropriate under *Bond*, because all the elements of these claims are not found within a single prior art reference.

Nevertheless, if the Examiner had rejected these claims based on § 103 instead of § 102(e), the Examiner would still not have provided a factual basis to show that the prior art teaches the desirability of combining Sanderson with McIntosh. *See In re Gordon*, 733 F.2d at 902, 221 U.S.P.Q. at 1127. Moreover, like the AAPA, Sanderson is not within the same or an analogous field as McIntosh, as Sanderson does not relate to haptic devices. *See In re Oetiker*, 977 F.2d at 1446, 24 U.S.P.Q.2d at 1445.

In view of the foregoing, it is respectfully asserted that the claims are now in condition for allowance.

Conclusion


It is believed that the claims are in condition for allowance. Early favorable consideration of this Amendment is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Respectfully submitted,
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